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EXAMINER

MOSSER, ROBERT E

| ART UNIT | PAPER NUMBER |
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|----------|--------------|

3712

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/688,898 | Applicant(s) SCHUGAR, DAVID | |
| | Examiner Robert Mosser | Art Unit 3712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,15-27,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 1,2,7-13 15-17,22,23, 25-27, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 18-21 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10-21-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION



This action is Final.

The IDS submitted 10-21-2003 is attached.

Claims 1, 2, 4-13, 15-27, and 35-36 are pending.



Previous Statements of Official Notice Presented in the Rejection Of October 18th, 2005 are noted as not being challenged by Applicant in their reply and hence now constitute Applicant Admitted Prior art

- (1) The examiner previously gave official notice that use of a "game piece" or "puck" is extremely old and well known in the art of gaming for indicating recording game progress and state to the player(s).
- (2) The examiner previously gave official notice that the deduction of house commission or house rake is extremely old and well known in the art of gaming for it's use in ensuring a minimum house profit on a gaming table.

Neither of the above statements was challenged in the Applicant's reply to office action dated March 27th, 2006 and hence has become Applicant admitted prior art.

Claim Objections

Claim 1 is objected to because of the following informalities: Line 11 of claim 1 states "continuing the moving until the piece...", and is presently utilizing the term moving as a noun, For purposes of examination this phrase has been interpreted as "continuing the moving of the piece until the piece....". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1-2, 7-9, 13, 15-17, 22-23, 25-27, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber (US 6,896,264).

Claims 1, 7, 15, and 23: Haber teaches a method and apparatus for a casino game including the display of a linear playing field including a first and second end (Figure 1, "Higher-Lower"), receiving a wager that the game outcome will be located at one of the two ends (Abstract), the determination of a game result based on the outcome of a random number generator utilizing the roll of dice (Elements 310, 350), and accounting for the wager based on the game result (Figure 3).

Haber is silent however regarding the explicit use of a "game piece" or puck for the indication of the current state of the game and in its stead utilizes "marking" (Col 3:47-59) and a display board (Col 4:4-18) for conveying the result of game outcomes to a player. It is Applicant admitted prior art that use of a "game piece" or "puck" is extremely old and well known in the art of gaming for indicating recording game progress and state to the player(s). It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized a game piece or puck in place of the game state indicators of Haber as taught above in order to provide an indicator in keeping the intended game theme or alternatively offer the player and readily recognizable visual reference proximate to subsequent game result locations.

Exemplary Correlation

Haber teaches a method of playing a dice wagering casino game including: displaying a linear playing field with a center, two ends (Elm 210) and a piece in an initial position (wherein the initial position for a piece in any given round is

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determined by the last random game outcome EX. A roll of 7 [See Col 4:4-18 & in addition to the modification with the marker above]);

Receiving a first wager that the piece will reach a first desired end comprising either the first or second end (wherein this equates to allowing the player to place a wager on two consecutive rolls of "12" with the end represented by 12 [Elm 300]);

Moving the piece in either direction on the field to a further position in accordance with a random number generator (Equated to the piece or marker taking the place of the number randomly determined by the dice [Elm 310]);

Receiving a second wager that the piece will reach a second desired end with a payout on the second wager reflecting the chances that the piece will be moved to reach the second further position (This equates to allowing the player to place a single roll bet on the next random game outcome represented by the next location of a game marker [Elm 340]); and

[In order to recap, At this point the player has one consecutive roll bet placed on the occurrence of subsequent "12" dice roll outcomes with one "12" outcome already determined and has placed an additional single roll bet on the occurrence of a "2" in the upcoming round, hence providing for a wager placed on a first desired end (12) and a second desired end (2)]

Continuing the moving until the piece reaches either the first end or the second end and then accounting for the first wager and the second wager (This equates to a subsequent roll of "12" [Elm 350] the end of the linear playing field [Elm 210] and resulting in a losing outcome for the player's single roll [Elm 360] and a winning outcome for the player's consecutive roll bet [Elm 370] that are resolved by the croupier).

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Claims 2, and 16: In addition to the gaming device and method taught above Haber is silent regarding the deduction of a house commission. It is Applicant admitted prior art that the deduction of house commission or house rake is extremely old and well known in the art of gaming for it's use in ensuring a minimum house profit on a gaming table. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a house commission in the game of Haber in order to ensure a minimum house take on the outcome of even a winning hand and thereby minimize house losses.

Haber additional teaches an even payout when a wager is made in the center ("7" Figure 1A, & Fig 4 "1 to 1") however is silent regarding the association of this payout with a first wager (a two roll bet as set forth above). It would have been obvious to one of ordinary skill in the art at the time of invention to alter the payouts of the existing two roll combinations or alternatively incorporate a 7/11 two roll bet in order to adjust game volatility and/or provide the player with additional wagering opportunities.

Claim 8: Haber teaches the use of table locations for the indication of wager placement (Col 3:47-59).

Claims 9, and 17: Haber teaches appropriating payout amounts based on subsequent game outcomes (Col 3:1-8).

Claims 13, and 22: Haber teaches a game progression including a game event wherein players are allowed to place and alter wagers (Figure 3, Col 3:5-8).

Claims **25**, and **35**: Haber teaches allowing the player to cancel a two roll bet after the first roll and realize a net guaranteed win with a 5 to 4 payout (Col 3:5-8).

Claims **26-27**, and **36**: Haber teaches allowing the player to play multiple bets/wagers and as such would allow a player to wager on all game outcomes thereby ensuring a player a chance of a net win implicitly greater than zero in at least one of a plurality of games.

Claims **10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber (US 6,896,264) in further view of Sink or Swim 9/16/2003 Black Box gaming.

Haber teaches the use of location including fields (Figure 1) to indicate respective player's wagers however is silent regarding the utilization of lines to indicate a respective player associated with a particular wager. In a related wagering game Sink or Swim teaches the use of a line system to indicate a respective player associated with a particular wager (Full Text). It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized the wager indication system of Sink or Swim in the invention of Haber in order to minimize chip movement across the gaming table during play and further allow the player to readily track current wagers.

Allowable Subject Matter

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Claims **18-21**, and **24** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims **4-6** are allowed.

Response to Arguments

Applicant's arguments filed March 27th, 2006 have been fully considered but they are not persuasive.

I) Applicant states that Haber does not teach or disclose a piece that moves in a direction (Page 6/9 of Applicant Remarks dated March 27, 2006).

For the purposes of the rejection presented, the incorporation of a "puck" as a game indicia element was previously relied upon through the use of official notice. The key here is the prior art of Haber tracks the previously game outcomes and uses the previous game outcome to determine current game outcomes (i.e. on the last roll of a two roll wager). Hence the modification of Haber (who as stated already tracks the previous game outcomes) is to include the use of a "puck" for indicating the previous game outcome on a linear playing field (already present in Haber as Element 210).

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II) Applicant proposes that even with the introduction of a the Puck as presented in the rejection of the claims and item 1 above, there is no disclosed movement of the "puck" as disclosed in claim 1 (Page 7/9 of Applicant Remarks dated March 27, 2006).

By way of example if the previous roll of the dice resulted in a "7" the indicator or puck would be moved to that position. On the subsequent roll the outcome could result in an outcome that is higher or lower and thereby would result in the movement of the indicator or puck to that position on the linear path hence providing for the movement of the indicator as claimed.

III) Applicant questions the whether the newly provided limitation directed to a second wager is provided for in the prior art (Page 7/9 of Applicant Remarks dated March 27, 2006).

This feature has been in the example now attached to at least the rejection of claim 1 above.

IV) Applicant's claim language in claims **25** and **35** is directed a betting opportunity that would guarantee the player a net win. This claim limitation has been interpreted in view of page 20 of the applicant's specification, however this claim language does not incorporate any conditional type limitations of when the player is verses is not notified of this betting opportunity. Considered in a separate light the presented limitation of claims 25 and 35 states a wagering system that always presents the user with a net win. An always net winning outcome would no longer be a betting or wagering device

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per se as the player/user would make money with each wager. As this limitation conflicts with the remainder of the claims limitations it has been given limited weight. If the applicant intends to further prosecution of these claims (25 and 35) it is requested that they provide clarification in these claims and/or arguments related thereto.

Observations

The Applicant presently is indirectly arguing their claims of a narrower scope than reflected in their claims. Applicant is arguing the movement of a piece on a linear game path wherein the determination of future piece placement is based on the current position of the piece. However the present construction of the claims only provide for the end location of the piece at each step of the game. In short the claims do not address the inter-relation between the previous placement of the piece and the subsequent placement of the piece only the final locations for each stage. Consideration towards a forward and backwards movement piece should also be maintained to avoid regression into the prior art device of US 1797742, or similar horse simulations. In no case should this observation be considered an expression of allowable subject matter but instead is provided merely clarify the issues at hand.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Wright (US 3645531) teaches a randomly operated picture projection change apparatus.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M.Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM


SCOTT JONES
PRIMARY EXAMINER